

### **Remarks**

Claims 1-6 remain in this application and are presented for the Examiner's review and consideration. Claims 1 and 2 have been amended, and claim 6 has been added. Applicants believe the amendments and remarks herein serve to clarify the present invention and are independent of patentability.

### **Allowable Subject Matter**

Applicants acknowledge with appreciation that claim 2 was indicated as being allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph. In response, Applicants have rewritten claim 2 in independent form and amended the claim to overcome the §112 rejection.

### **Priority Claim**

In the Office Action, it was noted that a certified copy of the Austrian priority patent application has not been filed. In accordance with 35 U.S.C. §119(b), Applicants have provided a certified copy of the application herewith.

### **Information Disclosure Statement**

It was also noted in the Office Action that the specification, specifically the background of the invention, recited two prior art references that were not listed on the previously submitted Information Disclosure Statement. In response, Applicants have provided herewith an Information Disclosure Statement listing the two prior art references. The appropriate fee for the submission of the Information Disclosure Statement is submitted herewith in accordance with 37 C.F.R. §1.17(p).

### **35 U.S.C. §112 Rejection**

Claims 1 and 2 were rejected under 35 U.S.C. §112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response and as recommended by the Examiner, Applicants have amended the claims to define the invention to skis generally.

### 35 U.S.C. §103 Rejection

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,369,821 to Weber ("Weber") in view of U.S. Patent No. 4,077,652 to McCaskey, Jr. *et al.* ("McCaskey"). In response, Applicants respectfully submit that this rejection should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *see* MPEP § 2143.

Weber discloses a core unit for laminated skis. As plastics or synthetic resins have found wide application in the manufacture of skies, it is natural that attempts have been made to make the core unit of plastic or synthetic resin material. (col. 1, lns. 25-37). An object of the invention is to provide a ski core unit comprising at least one laminated construction formed of bands or strips of plastic or synthetic resin material adhered to each other. Another object of the invention is to provide a laminated ski core unit, laminated of strips or bands of plastic or synthetic resin material, in which the strips or bands may be formed as extrusions. A further object of the invention is to provide a laminated ski core unit consisting of bands or strips of plastic or synthetic resin laminated to each other, and formed with recesses, cutouts, or the like for weight reduction. (col. 1, ln. 60 to col. 2, ln. 4).

The bands or laminas of Weber's core unit are illustrated in Figs. 1, 2, 3, 4, 6, 8, 9 and 10. As shown in Fig. 1, slot-type discontinuities are provided in the plastic or synthetic resin. (col. 2, lns. 44-47). As illustrated in Fig. 2, the lamina includes rectangular grooves separated by rectangular ribs. (col. 2, lns. 57-58). As seen in Fig. 3, the lamina includes triangular grooves with trapezoidal ribs. (col. 2, lns. 61-62). As illustrated in Fig. 4, the lamina includes rectangular grooves separated by rectangular ribs on both sides of the lamina. (col. 2, lns. 63-66). As shown in Figs. 6, 8 and 9, the lamina includes semicircular grooves. (col. 3, lns. 28-71). The semicircular cross-section of each groove lies in the transverse plan of the lamina. (Figs. 6, 8 and 9). As seen in Fig. 10, a special form of lamina includes grooves separated by ribs. (col. 3, lns. 72-73). The arced cross-section of each groove of Fig. 10 lies in the transverse plan of the lamina. (Fig. 10).

McCaskey discloses a high performance, metal-fiberglass snow ski. (col. 2, lns. 5-6). The core of the ski can be a hollow plastic core of epoxy resin reinforced fiberglass, a lightweight epoxy or polyurethane foam core, an aluminum honeycomb core or a suitable, pressed, light-weight wood core.

Applicants, on the other hand, disclose a light-weight construction core made of wood for sliding bodies, e.g., skis. (abstract). From the running surface side, grooves or slits are cut into the core. The grooves are arranged in successive rows extending parallel to the longitudinal axis of the ski. The successive grooves have equal lengths and are offset by half a groove length relative to the grooves of the neighboring row. As shown in Fig. 3, the elongate grooves have rounded corners. (p. 3 bottom to p. 4 top). As shown in Fig. 5, the grooves are semi-circular in shape. (p. 4, 3rd para. from bottom).

Initially, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. As previously provided, Weber recognized, in 1965, that plastics and synthetic resins were being used in the manufacture of skis. Therefore, it was an objective of Weber to make a core unit for a ski out of plastic or synthetic resin material. It was a further

objective of Weber to make the core unit of laminated strips or bands of plastic or synthetic resin material. It was yet a further objective to make the core unit from strips of plastic or synthetic resin material with recesses or cutouts for weight reduction. Meanwhile, McCaskey teaches a ski having a wood core.

Accordingly, Applicants submit that there is no suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine Weber and McCaskey. The primary objective of Weber is to manufacture a ski core unit made of plastic or synthetic resin material. Weber recognized the growing use of plastics and resin material in ski construction and therefore invented and patented a core unit made from plastic or synthetic resin material. Accordingly, Applicants contend that there is no suggestion or motivation to combine McCaskey's wood core with Weber's plastic or synthetic resin core unit because doing so would defeat the objectives that Weber's core unit seeks to obtain, which is to make a core unit out of a plastic or synthetic resin material.

Additionally, there is no reasonable expectation of success in combining the references. As previously mentioned, Weber discloses the construction a ski core unit made of plastic or synthetic resin material, while McCaskey teaches a wood core for skis. Applicants contend that using McCaskey's wood core in Weber's core unit would create no expectation of success in achieving Weber's objective: i.e., constructing a core unit made from plastic or synthetic resin material. Combining McCaskey's wood core with Weber's core unit would destroy Weber's invention.

Finally, Applicants contend that the prior art references, alone or in combination, fail to teach or suggest all the claim limitations. For example, amended claim 1 recites, *inter alia*, that each groove or slit has a circular-arc-shape defining a top surface and two longitudinal end surfaces. (Similarly, new claim 6 recites, *inter alia*, that each groove or slit has an elongate shape including a top surface, two longitudinal end surfaces, and rounded corners connecting the top surface with the longitudinal end surfaces.) In the Office Action, the Examiner stated that although the shape of the grooves in Fig. 10 of Weber is viewed in the cross section and not the longitudinal section, the circular-arc-shape would still exist

when the core is viewed in the longitudinal section but would not be viewed as clearly. Applicants contend that the circular-arc-shape of Weber's groove is positioned between the lateral side walls of the groove and the top surface of the groove. Regardless of what sectional view is taken of the groove, Weber fails to teach or suggest a groove as defined in amended claim 1 (and new claim 6). Applicants further submit that McCaskey fails to overcome the deficiencies of Weber with respect to the characteristics of the claimed invention.

Accordingly, Applicants respectfully submit that the examiner has failed to establish a *prima facie* case of obviousness. Applicants submit that independent claim 1 is patentable over the cited references.

#### New Claims

Applicants have added independent claim 6. Support for this new claim may be found throughout the specification with emphasis on page 4 and Fig. 3 of the specification. Applicants further submit that claim 6 is patentable over the cited references as provided above.

#### Conclusion

In light of the foregoing, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

A fee of \$180 is believed to be due for the submission of an Information Disclosure Statement. A credit card payment form is submitted herewith. Please charge any additional

Applicant(s): J. Heftberger  
Application No.: 10/747,882  
Examiner: C. Bottorff

fees (or credit any overpayments of fees) to the Deposit Account of the undersigned,  
Account No. 500601 (Docket No. 7590-X03-004).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. D. Bianco', with a long horizontal flourish extending to the right.

Paul D. Bianco, Reg. # 43,500  
Martin Fleit, Reg. # 16,900

Customer Number: 27317  
Martin Fleit  
FLEIT KAIN GIBBONS GUTMAN BONGINI & BIANCO  
21355 East Dixie Highway, Suite 115  
Miami, Florida 33180  
Tel: 305-830-2600; Fax: 305-830-2605